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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|-----------------|-------------|----------------------|---------------------|------------------|
| 09/937,598 | 09/28/2001 | Takeshi Fujiyama | 1752-0147P | 2675 |

2292 7590 08/20/2003

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EXAMINER

ROBERTSON, JEFFREY

| ART UNIT | PAPER NUMBER |
|----------|--------------|
|----------|--------------|

1712

DATE MAILED: 08/20/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

DB-2

| | | | |
|------------------------------|---|--|--|
| Office Action Summary | Application N 09/937,598 | Applicant(s) FUJIYAMA ET AL. | |
| | Examiner Jeffrey B. Robertson | Art Unit 1712 | |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 28 September 2001.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-6 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 1-3 is/are allowed.
- 6) ☒ Claim(s) 4-6 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☒ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☒ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) <u>4,5</u> . | 6) <input type="checkbox"/> Other: |

DETAILED ACTION

Priority

1. Acknowledgment is made of applicant's claim for foreign priority based on an application filed in Japan on 3/30/99. It is noted, however, that there is no copy of the certified priority document in the application file. The examiner has tried to retrieve a copy of the priority document on line, but there is no copy available. Applicant is reminded that the examiner cannot allow the case without a certified copy of the priority document.

Information Disclosure Statement

2. It is noted that in the information disclosure statement submitted on December 20, 2001, the examiner has crossed out the Japanese abstracts listed under the foreign patent documents section and has cited the abstracts on the PTO-892 form. In the future, English abstracts should be cited under the "Other Documents" section, because they are not the Patent documents themselves.

Specification

3. The abstract of the disclosure is objected to because it is two paragraphs. Correction is required. See MPEP § 608.01(b).

Claim Rejections - 35 USC § 112

4. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

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5. Claims 4-6 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

For claim 4, the X_1 variable is undefined. A definition of this variable must be included in the claim to allow one of ordinary skill in the art to know the metes and bounds of the claim.

For claim 5, there is a lack of antecedent basis for "the terminal OH or OM group". It is unclear what terminal group applicant is referring to since no such group has been referred to previously in the claims.

Allowable Subject Matter

6. Claims 4-6 would be allowable if rewritten or amended to overcome the rejection(s) under 35 U.S.C. 112, second paragraph, set forth in this Office action.

7. Claims 1-3 are allowed.

8. The following is a statement of reasons for the indication of allowable subject matter: The closest prior art is Namba et al. (U.S. Patent No. 6,303,268). Namba teaches resist compositions containing ladder-type polyorganosilsesquioxanes, which may be end-capped with disiloxanes. Namba also teaches the protection of side chain groups with tert-butyl groups. Namba fails to teach or suggest a structure of applicant's general formula (1), where the residue of the disiloxanes is reacted to give a t-BOC group. The protected groups are on the methacrylate side chains or the silsesquioxane backbone. There is no indication in Namba that there are free terminal -OH groups after the end-capping treatment with the disiloxanes.

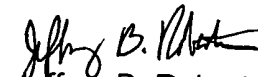
Conclusion

9. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Takemura et al. (U.S. Patent No 5,612,170), Lin et al. (U.S. Patent No. 6,210,856), and Nakashima et al. (U.S. Patent No. 6,309,796) are cited for general interest.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jeffrey B. Robertson whose telephone number is (703) 306-5929. The examiner can normally be reached on Mon-Fri 7:00-3:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Robert A. Dawson can be reached on (703) 308-2340. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 872-9306 for regular communications and (703) 872-9306 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0661.


Jeffrey B. Robertson
Primary Examiner
Art Unit 1712

JBR
August 11, 2003